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22 UNITED STATES DISTRICT COURT
23 NORTHERN DISTRICT OF CALIFORNIA
24 SAN FRANCISCO DIVISION

25 OVERTURE SERVICES, INC.,
26
27 Plaintiff,
28
29 v.
30
31 GOOGLE INC.,
32
33 Defendant.

E-Filing Case No.: 02-01991 JSW (EDL)

**CORRECTED APPENDIX A TO
MOTION TO COMPEL PRODUCTION
OF DAMAGES DOCUMENTS**

Hearing Date: March 9, 2004
Hearing Time: 9:00 a.m.
Hon. Elizabeth D. Laporte

**CORRECTED APPENDIX A TO MOTION TO COMPEL PRODUCTION OF
DAMAGES DOCUMENTS**

Plaintiff Overture Services, Inc.'s ("Overture") Motion to Compel requests that the Court set April 1, 2004 as the date for the production of "damages documents," as to which the parties agreed to delay production until after the claim construction hearing. Defendant Google, Inc. ("Google"), for the most part, did not proffer this agreement as an objection in its written responses to Overture's document requests, but rather simply has refrained from producing documents as to certain document requests that could be characterized as related to damages and now refuses to agree to any date certain or timeframe within which such documents will be produced.

Pursuant to Civil Local Rule 37-2, Overture sets forth below (1) document requests that Google stated were the Overture requests subject to the parties' 2002 agreement to delay production of documents related to damages (Requests Nos. 26, 32, 36-45, 52-57, 59-60), and (2) document requests as to which Google proffered a specific written objection that it would delay production of responsive damages-related documents (Requests Nos. 99, 107-110 and 112). For each request, Overture also sets forth Google's written objections and responses thereto, and Overture's contention as to why Overture is entitled to production of these documents on or before April 1, 2004.

Please note that, even where Google's written response agrees to produce the responsive documents and makes no mention of the parties' agreement to delay production until after the claim construction hearing, it is Overture's understanding that it is these requests as to which Google has withheld responsive documents to date and as to which Google has refused to provide any date certain or timeframe within which such documents will be produced. Overture's failure to identify a Request for Production below does not constitute an admission that such a Request is irrelevant to damages or that Google need not, if the Court grants Overture's motion, produce damages documents responsive to such a Request on or before April 1, 2004.

1
2 OVERTURE'S FIRST SET OF REQUESTS

3 REQUEST FOR PRODUCTION NO. 26:

4 All documents relating to any trade research, market research, consumer research, or
5 other research conducted by or on behalf of Google in connection with its decision to
6 design, develop, market, or operate Google's Sponsored Search System.

7 RESPONSE TO REQUEST FOR PRODUCTION NO. 26:

8 Google objects to this request on the ground that the term "Google's Sponsored
9 Search System" is vague, ambiguous and compound; and renders the request overbroad and
10 unduly burdensome. Subject to and without waiving the foregoing objection, Google
11 responds that it will produce documents within its possession that are responsive to this
12 request.

13 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

14 Overture is entitled to discovery from Google that relates to facts about Google's
15 accused Sponsored Search System that could form the basis for Overture's damages claim,
16 including those requested in Request No. 26. Documents about the market for the accused
17 system are relevant to the damages to which Overture is entitled by this lawsuit. *See* Fed.
18 R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of the
19 damages issue to the case and Overture's need for the information to prepare its damages
20 case and analysis, is not unreasonably cumulative or duplicative, and cannot be found from
21 a source other than Google without substantial difficulty, if at all. *See* Fed. R. Civ. P.
22 26(b)(2).

23 There is no justification for further delay in Google's producing these documents.
24 The claim construction hearing, which was set for March 2003 when the parties' made their
25 agreement to postpone damages discovery, is currently set for March 24, 2004. In addition,
26 this case is now nearly two years old. The vast majority of the document requests at issue
27 have been outstanding since August 2002; all will have been outstanding at least roughly
28 four months on April 1, 2004. Finally, Overture is requesting that Google be compelled to

1 produce the documents *after* the claim construction hearing, which accords in full with the
2 parties' 2002 agreement.

3 REQUEST FOR PRODUCTION NO. 32:

4 All documents relating to advertising plans, business plans, estimates, revenue
5 forecasts; web traffic reports, marketing plans or efforts, promotional programs, or
6 strategies on the part of Google concerning Google's Sponsored Search System.

7 RESPONSE TO REQUEST FOR PRODUCTION NO. 32:

8 Google objects to this request on the ground that the term "Google's Sponsored
9 Search System" is vague, ambiguous and compound, and renders the request overbroad and
10 unduly burdensome. Subject to and without waiving the foregoing objection, Google
11 responds that it will produce documents within its possession that are responsive to this
12 request.

13 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

14 Overture is entitled to discovery from Google that relates to facts about Google's
15 accused Sponsored Search System that could form the basis for Overture's damages claim,
16 including those requested in Request No. 32. Documents responsive to Request No. 32 are
17 relevant to the damages to which Overture is entitled by this lawsuit. *See* Fed. R. Civ. P.
18 26(b)(1). The discovery requested is proportional to the importance of the damages issue to
19 the case and Overture's need for the information to prepare its damages case and analysis, is
20 not unreasonably cumulative or duplicative, and cannot be found from a source other than
21 Google without substantial difficulty, if at all. *See* Fed. R. Civ. P. 26(b)(2).

22 Overture hereby incorporates by reference its discussion of the lack of justification
23 for further delay regarding Request No. 26.

24 REQUEST FOR PRODUCTION NO. 36:

25 All documents relating to the total revenue that Google has earned, directly or
26 indirectly, from the sale or advertisement of products or services through or in conjunction
27 with Google's Sponsored Search System.

28 RESPONSE TO REQUEST FOR PRODUCTION NO. 36:

1 Google objects to this request on the ground that the term “Google’s Sponsored
2 Search System” is vague, ambiguous and compound, and renders the request overbroad and
3 unduly burdensome. Subject to and without waiving the foregoing objection, Google
4 responds that it will produce documents within its possession that are responsive to this
5 request.

6 **WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:**

7 Overture is entitled to discovery from Google that relates to facts about Google’s
8 accused Sponsored Search System that could form the basis for Overture’s damages claim,
9 including those requested in Request No. 36. Documents related to the revenue earned from
10 the accused system are relevant to the damages to which Overture is entitled by this lawsuit.
11 *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of
12 the damages issue to the case and Overture’s need for the information to prepare its
13 damages case and analysis, is not unreasonably cumulative or duplicative, and cannot be
14 found from a source other than Google without substantial difficulty, if at all. *See* Fed. R.
15 Civ. P. 26(b)(2).

16 Overture hereby incorporates by reference its discussion of the lack of justification
17 for further delay regarding Request No. 26.

18 **REQUEST FOR PRODUCTION NO. 37:**

19 All documents relating to the profits earned by Google from the sale or
20 advertisement of products or services through or in conjunction with Google’s Sponsored
21 Search System.

22 **RESPONSE TO REQUEST FOR PRODUCTION NO. 37:**

23 Google objects to this request on the ground that the term “Google’s Sponsored
24 Search System” is vague, ambiguous and compound, and renders the request overbroad and
25 unduly burdensome. Google further objects to this request on the ground that the phrase
26 “through or in conjunction with” is vague and ambiguous. Subject to and without waiving
27 the foregoing objections, Google responds that it will produce documents within its
28 possession that are responsive to this request.

1 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

2 Overture is entitled to discovery from Google that relates to facts about Google's
3 accused Sponsored Search System that could form the basis for Overture's damages claim,
4 including those requested in Request No. 37. Documents related to Google's profits related
5 to the accused system are relevant to the damages to which Overture is entitled by this
6 lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the
7 importance of the damages issue to the case and Overture's need for the information to
8 prepare its damages case and analysis, is not unreasonably cumulative or duplicative, and
9 cannot be found from a source other than Google without substantial difficulty, if at all. *See*
10 Fed. R. Civ. P. 26(b)(2).

11 Overture hereby incorporates by reference its discussion of the lack of justification
12 for further delay regarding Request No. 26.

13 REQUEST FOR PRODUCTION NO. 38:

14 All income statements relating to Google's Sponsored Search System.

15 RESPONSE TO REQUEST FOR PRODUCTION NO. 38:

16 Google objects to this request on the ground that the term "Google's Sponsored
17 Search System" is vague, ambiguous and compound, and renders the request overbroad and
18 unduly burdensome. Subject to and without waiving the foregoing objection, Google
19 responds that it will produce documents within its possession that are responsive to this
20 request.

21 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

22 Overture is entitled to discovery from Google that relates to facts about Google's
23 accused Sponsored Search System that could form the basis for Overture's damages claim,
24 including those requested in Request No. 38. Income statements relating to Google's
25 accused system are relevant to the damages to which Overture is entitled by this lawsuit.
26 *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of
27 the damages issue to the case and Overture's need for the information to prepare its
28 damages case and analysis, is not unreasonably cumulative or duplicative, and cannot be

1 found from a source other than Google without substantial difficulty, if at all. *See* Fed. R.
2 Civ. P. 26(b)(2).

3 Overture hereby incorporates by reference its discussion of the lack of justification
4 for further delay regarding Request No. 26.

5 REQUEST FOR PRODUCTION NO. 39:

6 All balance sheets relating to Google's Sponsored Search System.

7 RESPONSE TO REQUEST FOR PRODUCTION NO. 39:

8 Google objects to this request on the ground that the term "Google's Sponsored
9 Search System" is vague, ambiguous and compound, and renders the request overbroad and
10 unduly burdensome. Subject to and without waiving the foregoing objection, Google
11 responds that it will produce documents within its possession that are responsive to this
12 request.

13 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

14 Overture is entitled to discovery from Google that relates to facts about Google's
15 accused Sponsored Search System that could form the basis for Overture's damages claim,
16 including those requested in Request No. 39. Balance sheets related to Google's accused
17 system are relevant to the damages to which Overture is entitled by this lawsuit. *See* Fed.
18 R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of the
19 damages issue to the case and Overture's need for the information to prepare its damages
20 case and analysis, is not unreasonably cumulative or duplicative, and cannot be found from
21 a source other than Google without substantial difficulty, if at all. *See* Fed. R. Civ. P.
22 26(b)(2).

23 Overture hereby incorporates by reference its discussion of the lack of justification
24 for further delay regarding Request No. 26.

25 REQUEST FOR PRODUCTION NO. 40:

26 All profit and loss statements relating to Google's Sponsored Search System.

27 RESPONSE TO REQUEST FOR PRODUCTION NO 40:

28 Google objects to this request on the ground that the term "Google's Sponsored

1 Search System” is vague, ambiguous and compound, and renders the request overbroad and
2 unduly burdensome. Subject to and without waiving the foregoing objection, Google
3 responds that it will produce documents within its possession that are responsive to this
4 request.

5 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

6 Overture is entitled to discovery from Google that relates to facts about Google’s
7 accused Sponsored Search System that could form the basis for Overture’s damages claim,
8 including those requested in Request No. 40. Profit and loss statements relating to Google’s
9 accused system are relevant to the damages to which Overture is entitled by this lawsuit.
10 *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of
11 the damages issue to the case and Overture’s need for the information to prepare its
12 damages case and analysis, is not unreasonably cumulative or duplicative, and cannot be
13 found from a source other than Google without substantial difficulty, if at all. *See* Fed. R.
14 Civ. P. 26(b)(2).

15 Overture hereby incorporates by reference its discussion of the lack of justification
16 for further delay regarding Request No. 26.

17 REQUEST FOR PRODUCTION NO. 41:

18 All audited or un-audited financial reports relating to Google’s Sponsored Search
19 System

20 RESPONSE TO REQUEST FOR PRODUCTION NO. 41:

21 Google objects to this request on the ground that the term “Google’s Sponsored
22 Search System” is vague, ambiguous and compound, and renders the request overbroad and
23 unduly burdensome. Subject to and without waiving the foregoing objection, Google
24 responds that it will produce documents within its possession that are responsive to this
25 request.

26 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

27 Overture is entitled to discovery from Google that relates to facts about Google’s
28 accused Sponsored Search System that could form the basis for Overture’s damages claim,

1 including those requested in Request No. 41. Financial reports relating to Google's accused
2 system are relevant to the damages to which Overture is entitled by this lawsuit. *See* Fed.
3 R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of the
4 damages issue to the case and Overture's need for the information to prepare its damages
5 case and analysis, is not unreasonably cumulative or duplicative, and cannot be found from
6 a source other than Google without substantial difficulty, if at all. *See* Fed. R. Civ. P.
7 26(b)(2).

8 Overture hereby incorporates by reference its discussion of the lack of justification
9 for further delay regarding Request No. 26.

10 **REQUEST FOR PRODUCTION NO. 42:**

11 All documents that identify any fees or costs incurred by Google in the design;
12 development, and operation of Google's Sponsored Search System.

13 **RESPONSE TO REQUEST FOR PRODUCTION NO. 42:**

14 Google objects to this request on the ground that the term "Google's Sponsored
15 Search System" is vague, ambiguous and compound, and renders the request overbroad and
16 unduly burdensome. Subject to and without waiving the foregoing objection, Google
17 responds that it will produce documents within its possession that are responsive to this
18 request.

19 **WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:**

20 Overture is entitled to discovery from Google that relates to facts about Google's
21 accused Sponsored Search System that could form the basis for Overture's damages claim,
22 including those requested in Request No. 42. Documents regarding Google's fees or costs
23 related to its accused system are relevant to the damages to which Overture is entitled by
24 this lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the
25 importance of the damages issue to the case and Overture's need for the information to
26 prepare its damages case and analysis, is not unreasonably cumulative or duplicative, and
27 cannot be found from a source other than Google without substantial difficulty, if at all. *See*
28 Fed. R. Civ. P. 26(b)(2).

Overture hereby incorporates by reference its discussion of the lack of justification for further delay regarding Request No. 26.

REQUEST FOR PRODUCTION NO. 43:

Documents sufficient to identify the amount and nature of all investments made by Google in facilities and equipment to design, develop, and operate Google's Sponsored Search System.

RESPONSE TO REQUEST FOR PRODUCTION NO. 43:

Google objects to this request on the ground that the term "Google's Sponsored Search System" is vague, ambiguous and compound, and renders the request overbroad and unduly burdensome. Subject to and without waiving the foregoing objection, Google responds that it will produce documents within its possession that are responsive to this request.

WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

Overture is entitled to discovery from Google that relates to facts about Google's accused Sponsored Search System that could form the basis for Overture's damages claim, including those requested in Request No. 43. Documents regarding Google's investments in its accused system are relevant to the damages to which Overture is entitled by this lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of the damages issue to the case and Overture's need for the information to prepare its damages case and analysis, is not unreasonably cumulative or duplicative, and cannot be found from a source other than Google without substantial difficulty, if at all. *See* Fed. R. Civ. P. 26(b)(2).

Overture hereby incorporates by reference its discussion of the lack of justification for further delay regarding Request No. 26.

REQUEST FOR PRODUCTION NO. 44:

Documents sufficient to establish the cost to Google of advertising, marketing, and providing the products or services that it offers through or in conjunction with Google's Sponsored Search System.

1 RESPONSE TO REQUEST FOR PRODUCTION NO. 44:

2 Google objects to this request on the ground that the term “Google’s Sponsored
3 Search System” is vague, ambiguous and compound, and renders the request overbroad and
4 unduly burdensome. Subject to and without waiving the foregoing objection, Google
5 responds that it will produce documents within its possession that are responsive to this
6 request.

7 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

8 Overture is entitled to discovery from Google that relates to facts about Google’s
9 accused Sponsored Search System that could form the basis for Overture’s damages claim,
10 including those requested in Request No. 44. Documents regarding Google’s costs relating
11 to the accused system are relevant to the damages to which Overture is entitled by this
12 lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the
13 importance of the damages issue to the case and Overture’s need for the information to
14 prepare its damages case and analysis, is not unreasonably cumulative or duplicative, and
15 cannot be found from a source other than Google without substantial difficulty, if at all. *See*
16 Fed. R. Civ. P. 26(b)(2).

17 Overture hereby incorporates by reference its discussion of the lack of justification
18 for further delay regarding Request No. 26.

19 REQUEST FOR PRODUCTION NO. 45:

20 All documents that identify and explain Google’s accounting books and records as
21 they relate to Google’s Sponsored Search System.

22 RESPONSE TO REQUEST FOR PRODUCTION NO. 45:

23 Google objects to this request on the ground that the term “Google’s Sponsored
24 Search System” is vague, ambiguous and compound, and renders the request overbroad and
25 unduly burdensome. Subject to and without waiving the foregoing objection, Google
26 responds that it will produce documents within its possession that are responsive to this
27 request.

28 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

Overture is entitled to discovery from Google that relates to facts about Google's accused Sponsored Search System that could form the basis for Overture's damages claim, including those requested in Request No. 45. Google's accounting books and records relating to the accused system are relevant to the damages to which Overture is entitled by this lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of the damages issue to the case and Overture's need for the information to prepare its damages case and analysis, is not unreasonably cumulative or duplicative, and cannot be found from a source other than Google without substantial difficulty, if at all. *See* Fed. R. Civ. P. 26(b)(2).

Overture hereby incorporates by reference its discussion of the lack of justification for further delay regarding Request No. 26.

REQUEST FOR PRODUCTION NO. 52:

All documents relating to any patent license(s) that Google contends are relevant to their issues of damages or a reasonable royalty in this case.

RESPONSE TO REQUEST FOR PRODUCTION NO. 52:

Google objects to this request to the extent that it tails for documents protected by the attorney-client privilege, or the work-product doctrine. Subject to and without waiving the foregoing objection, Google responds that it will produce non-privileged documents within its possession that are responsive to this request.

WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

Documents relating to licenses that Google believes are relevant to damages in this case are, in fact, relevant to the damages to which Overture is entitled by this lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of the damages issue to the case and Overture's need for the information to prepare its damages case and analysis, is not unreasonably cumulative or duplicative, and cannot be found from a source other than Google without substantial difficulty, if at all. *See* Fed. R. Civ. P. 26(b)(2).

Overture hereby incorporates by reference its discussion of the lack of justification

1 for further delay regarding Request No. 26.

2 REQUEST FOR PRODUCTION NO. 53:

3 All documents relating to or upon which Google will rely in support of any amount
4 or rate that Google considers to be a reasonable royalty for their use or operation of
5 Google's Sponsored Search System, as it relates to the '361 patent.

6 RESPONSE TO REQUEST FOR PRODUCTION NO. 53:

7 Google objects to this request on the ground that the term "Google's Sponsored
8 Search System" is vague, ambiguous and compound, and renders the request overbroad and
9 unduly burdensome. Google further objects to this request to the extent that it calls for
10 documents protected by the attorney-client privilege or the work-product doctrine. Subject
11 to and without waiving the foregoing objection, Google responds that it will produce non-
12 privileged documents within its possession that are responsive to this request.

13 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

14 Overture is entitled to discovery from Google that relates to facts about Google's
15 accused Sponsored Search System that could form the basis for Overture's damages claim,
16 including those requested in Request No. 53. Documents relating to Google's position on
17 reasonable royalty are relevant to the damages to which Overture is entitled by this lawsuit.
18 *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of
19 the damages issue to the case and Overture's need for the information to prepare its
20 damages case and analysis, is not unreasonably cumulative or duplicative, and cannot be
21 found from a source other than Google without substantial difficulty, if at all. *See* Fed. R.
22 Civ. P. 26(b)(2).

23 Overture hereby incorporates by reference its discussion of the lack of justification
24 for further delay regarding Request No. 26.

25 REQUEST FOR PRODUCTION NO. 54:

26 All documents relating to the nature, size, and scope of the market for, the
27 availability of, and the demand for Sponsored Search Systems in general or Google's
28 Sponsored Search System in particular.

1 RESPONSE TO REQUEST FOR PRODUCTION NO. 54:

2 Google objects to this request on the ground that the terms “Sponsored Search
3 Systems” and “Google’s Sponsored Search System” are vague, ambiguous and compound,
4 and render the request overbroad and unduly burdensome. Google further objects to this
5 request to the extent that it calls for documents protected by the attorney-client privilege or
6 the work-product doctrine. Subject to and without waiving the foregoing objection, Google
7 responds that it will produce non-privileged documents within its possession that are
8 responsive to this request.

9 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

10 Documents relating to the market for the accused system and sponsored search
11 systems generally are relevant to the damages to which Overture is entitled by this lawsuit.
12 *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of
13 the damages issue to the case and Overture’s need for the information to prepare its
14 damages case and analysis, is not unreasonably cumulative or duplicative, and cannot be
15 found from a source other than Google without substantial difficulty, if at all. *See* Fed. R.
16 Civ. P. 26(b)(2).

17 Overture hereby incorporates by reference its discussion of the lack of justification
18 for further delay regarding Request No. 26.

19 REQUEST FOR PRODUCTION NO. 55:

20 All documents relating to Google’s market share as a percentage of total sales in the
21 Sponsored Search Systems industry, whether expressed in units or dollars.

22 RESPONSE TO REQUEST FOR PRODUCTION NO. 55:

23 Google objects to this request on the ground that the term “Sponsored Search
24 Systems” is vague, ambiguous and compound, and renders the request overbroad and
25 unduly burdensome. Google further objects to this request to the extent that it calls for
26 documents protected by the attorney-client privilege or the work-product doctrine. Subject
27 to and without waiving the foregoing objection, Google responds that it will produce non-
28 privileged documents within its possession that are responsive to this request.

1 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

2 Documents relating to Google's market share are relevant to the damages to which
3 Overture is entitled by this lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The discovery requested
4 is proportional to the importance of the damages issue to the case and Overture's need for
5 the information to prepare its damages case and analysis, is not unreasonably cumulative or
6 duplicative, and cannot be found from a source other than Google without substantial
7 difficulty, if at all. *See* Fed. R. Civ. P. 26(b)(2).

8 Overture hereby incorporates by reference its discussion of the lack of justification
9 for further delay regarding Request No. 26.

10 REQUEST FOR PRODUCTION NO. 56:

11 All documents relating to Sponsored Search System products or services that have
12 been marketed or sold in competition with Google's Sponsored Search System, including
13 any competitive analyses of such products or services.

14 RESPONSE TO REQUEST FOR PRODUCTION NO. 56:

15 Google objects to this request on the ground that the terms "Sponsored Search
16 Systems" and "Google's Sponsored Search System" are vague, ambiguous and compound,
17 and render the request overbroad and unduly burdensome. Google further objects to this
18 request to the extent that it calls for documents protected by the attorney-client privilege or
19 the work-product doctrine Subject to and without waiving the foregoing objection, Google
20 responds that it will produce non-privileged documents within its possession that are
21 responsive to this request.

22 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

23 Documents relating to products and services competing with the accused system are
24 relevant to the damages to which Overture is entitled by this lawsuit. *See* Fed. R. Civ. P.
25 26(b)(1). The discovery requested is proportional to the importance of the damages issue to
26 the case and Overture's need for the information to prepare its damages case and analysis, is
27 not unreasonably cumulative or duplicative, and cannot be found from a source other than
28 Google without substantial difficulty, if at all. *See* Fed. R. Civ. P. 26(b)(2).

Overture hereby incorporates by reference its discussion of the lack of justification for further delay regarding Request No. 26.

REQUEST FOR PRODUCTION NO. 57:

All documents relating to each product, system, or service that Google contends is an acceptable non-infringing alternative to the apparatus, systems, or methods claimed in the `361 patent.

RESPONSE TO REQUEST FOR PRODUCTION NO. 57:

Google objects to this request to the extent that it calls for documents protected by the attorney-client privilege or the work-product doctrine. Subject to and without waiving the foregoing objection. Google responds that it will produce non-privileged documents within its possession that are responsive to this request.

WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

Documents relating to alleged non-infringing alternatives are relevant to the damages to which Overture is entitled by this lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of the damages issue to the case and Overture's need for the information to prepare its damages case and analysis, is not unreasonably cumulative or duplicative, and cannot be found from a source other than Google without substantial difficulty, if at all. *See* Fed. R. Civ. P. 26(b)(2).

Overture hereby incorporates by reference its discussion of the lack of justification for further delay regarding Request No. 26.

REQUEST FOR PRODUCTION NO. 59:

All documents relating to any consideration, negotiation, recommendation, or proposal to license, buy, acquire, or otherwise obtain rights under the `361 patent.

RESPONSE TO REQUEST FOR PRODUCTION NO. 59:

Google objects to this request to the extent that it calls for documents protected by the attorney-client privilege or the work-product doctrine. Google further objects to this request to the extent that it calls for documents that are readily obtainable from Plaintiff or from other sources which are less burdensome and/or less expensive. Subject to and

1 without waiving the foregoing objections, Google responds that it will produce non-
2 privileged documents within its possession that are responsive to this request.

3 **WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:**

4 Documents relating to obtaining the rights to the '361 patent at issue in this lawsuit
5 are relevant to the damages to which Overture is entitled by this lawsuit. *See* Fed. R. Civ.
6 P. 26(b)(1). The discovery requested is proportional to the importance of the damages issue
7 to the case and Overture's need for the information to prepare its damages case and
8 analysis, is not unreasonably cumulative or duplicative, and cannot be found from a source
9 other than Google without substantial difficulty, if at all. *See* Fed. R. Civ. P. 26(b)(2).

10 Overture hereby incorporates by reference its discussion of the lack of justification
11 for further delay regarding Request No. 26.

12 **REQUEST FOR PRODUCTION NO. 60:**

13 All documents relating to any money or monetary funds that have ever been set
14 aside, put in escrow, or designated for settlement or payment of damages relating to
15 Google's infringement or potential infringement of the '361 patent or any other patent.

16 **RESPONSE TO REQUEST FOR PRODUCTION NO. 60:**

17 Google objects to this request to the extent that it calls for documents protected by
18 the attorney-client privilege or the work-product doctrine. Subject to and without waiving
19 the foregoing objection, Google responds that it will produce non-privileged documents
20 within its possession that are responsive to this request.

21 **WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:**

22 Documents relating to money set aside for settlement or damages payments for
23 patent infringement are relevant to the damages to which Overture is entitled by this
24 lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the
25 importance of the damages issue to the case and Overture's need for the information to
26 prepare its damages case and analysis, is not unreasonably cumulative or duplicative, and
27 cannot be found from a source other than Google without substantial difficulty, if at all. *See*
28 Fed. R. Civ. P. 26(b)(2).

Overture hereby incorporates by reference its discussion of the lack of justification for further delay regarding Request No. 26.

OVERTURE'S FIFTH SET OF REQUESTS

REQUEST FOR PRODUCTION NO. 99:

All documents relating to any discussions, meetings, or communications of any sort between Google and Terra Lycos concerning the '361 patent.

RESPONSE TO REQUEST FOR PRODUCTION NO. 99:

Google objects to this request to the extent that it calls for documents protected by the attorney-client privilege, the work product doctrine, and/or any other privileges or immunities. Google further objects to this request to the extent-that the phrase "concerning the '361 patent" calls for a legal conclusion. Subject to any without waiving the foregoing objections, Google responds that it will produce non-privileged documents responsive to this request to the extent that they exist and have not already been produced. To the extent that any such documents relate only to damages issues, pursuant to the parties' agreement to phase damages discovery, such documents will be produced in the damages phase of discovery.

WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

Documents relating to discussions and the like between Google and Terra Lycos regarding the '361 patent at issue in this lawsuit are relevant to the damages to which Overture is entitled by this lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of the damages issue to the case and Overture's need for the information to prepare its damages case and analysis, is not unreasonably cumulative or duplicative, and cannot be found from a source other than Google without substantial difficulty, if at all. *See* Fed. R. Civ. P. 26(b)(2).

Overture hereby incorporates by reference its discussion of the lack of justification for further delay regarding Request No. 26.

REQUEST FOR PRODUCTION NO. 107:

All documents relating to any licenses, agreements, partner agreements, or letters of

1 intent entered into by Google and Terra Lycos relating to Google's Sponsored Search
2 System, including, but not limited to any licenses, agreements, partner agreements, or letters
3 of intent.

4 RESPONSE TO REQUEST FOR PRODUCTION NO. 107:

5 Google objects to this request to the extent that it seeks documents concerning any
6 Google's Sponsored Search System that ceased to be used prior to the issuance of the
7 Patent-in-Suit, on July 31, 2001. Google's response is limited to Google's Sponsored
8 Search Systems that have been in use since the issuance of Patent-in-Suit. Based on
9 discussions between counsel for Overture and Google, Google understands the term
10 "Google's Sponsored Search System" to be limited to advertising models that are priced on
11 a "cost-per-click" pricing model. Based on that understanding and the time limitation noted
12 above, Google understands the term "Google's Sponsored Search System" to be limited to
13 AWS. Google further objects to this request to the extent that it purports to require the
14 production of documents protected by the attorney-client privilege, the work product
15 doctrine, or any other privileges or immunities. Subject to and without waiving the
16 foregoing object, Google responds that, to the extent that there are nonprivileged documents
17 within its possession, custody, or control that are responsive to this request, that relate to
18 AWS, and that pre-date the filing of this lawsuit, Google will produce such documents to
19 the extent that they exist and have not already been produced; to the extent that there are
20 non-privileged documents within its possession, custody, or control that are responsive to
21 this request, that relate to AWS, and that post-date the filing of this lawsuit, such documents
22 can only be related to damages issues, and pursuant to the parties' agreement to phase
23 damages discovery; such documents will be produced in the damages phase of discovery.

24 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

25 Overture is entitled to discovery from Google that relates to facts about Google's
26 accused Sponsored Search System that could form the basis for Overture's damages claim,
27 including those requested in Request No. 107. Documents relating to licenses or
28 agreements between Google and Terra Lycos regarding the accused system, regardless of

1 their date, are relevant to the damages to which Overture is entitled by this lawsuit. *See*
2 Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of the
3 damages issue to the case and Overture's need for the information to prepare its damages
4 case and analysis, is not unreasonably cumulative or duplicative, and cannot be found from
5 a source other than Google without substantial difficulty, if at all. *See* Fed. R. Civ. P.
6 26(b)(2).

7 Overture hereby incorporates by reference its discussion of the lack of justification
8 for further delay regarding Request No. 26.

9 REQUEST FOR PRODUCTION NO. 108:

10 All documents relating to any licenses, agreements, partner agreements, or letters of
11 intent entered into by Google and Terra Lycos relating to sponsored search links, including,
12 but not limited to, any licenses, agreements, partner agreements, or letters of intent.

13 RESPONSE TO REQUEST FOR PRODUCTION NO. 108:

14 Google objects to this request on the ground that the phrase "sponsored search links"
15 is overly broad to the extent that it includes sponsored search links" that are beyond the
16 scope of AWS, which is the only service that Overture has asserted allegedly infringes the
17 patent in suit, and thus this request seeks in part documents that are neither relevant to the
18 claims or defenses raised in this action, nor reasonably calculated to lead to the discovery of
19 admissible evidence. Google objects to this request to the extent that it seeks documents
20 concerning any Google's Sponsored Search System that ceased to be used prior to the
21 issuance of the Patent-in-Suit, on July 31, 2001. Google's response is limited to Google's
22 Sponsored Search Systems that have been in use since the issuance of the Patent-in-Suit.
23 Based on discussions between counsel for Overture and Google, Google understand the
24 term "Google's Sponsored Search System" to be limited to advertising models that are
25 priced on a "cost-per-click" pricing model. Based on that understanding and the time
26 limitation noted above, Google understands the term "Google's Sponsored Search System"
27 to be limited to AWS. Google further objects to this request to the extent that it purports to
28 require the production of documents protected by the attorney-client privilege, the work

1 product doctrine, and/or any other privileges or immunities. Subject to and without waiving
2 the foregoing objections, Google responds that it will produce documents as stated in its
3 response to Request for Production No. 107.

4 **WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:**

5 Documents relating to licenses or agreements between Google and Terra Lycos
6 regarding sponsored search links, including regarding the accused system, are relevant to
7 the damages to which Overture is entitled by this lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The
8 discovery requested is proportional to the importance of the damages issue to the case and
9 Overture's need for the information to prepare its damages case and analysis, is not
10 unreasonably cumulative or duplicative, and cannot be found from a source other than
11 Google without substantial difficulty, if at all. *See* Fed. R. Civ. P. 26(b)(2).

12 Overture hereby incorporates by reference its discussion of the lack of justification
13 for further delay regarding Request No. 26.

14 **REQUEST FOR PRODUCTION NO. 109:**

15 All documents relating to any licenses, agreements, partner agreements, or letters of
16 intent entered into by Google and Terra Lycos relating to sponsored links, including, but not
17 limited to, any licenses, agreements, partner agreements, or letters of intent.

18 **RESPONSE TO REQUEST FOR PRODUCTION NO. 109:**

19 Google objects to this request on the ground that the phrase "sponsored links" is
20 overly broad to the extent that it includes "sponsored links" that are beyond the scope of
21 AWS, which is the only service that Overture has asserted allegedly infringes the patent in
22 suit, and thus this request seeks in part documents that are neither relevant to the claims or
23 defenses raised in this action, nor reasonably calculated to lead to the discovery of
24 admissible evidence. Google objects to this request to the extent that it seeks documents
25 concerning any Google's Sponsored Search System that ceased to be used prior to the
26 issuance of the Patent-in-Suit, on July 31, 2001. Google's response is limited to Google's
27 sponsored Search Systems that have been in use since the issuance of the Patent-in-Suit.
28 Based on discussions between counsel for Overture and Google, Google understands the

1 term “Google’s Sponsored Search System” to be limited to advertising models that are
2 priced on a “cost-per-click” pricing model. Based on that understanding and the time
3 limitation noted above, Google understands the term “Google’s Sponsored Search System”
4 to be limited AWS. Google further objects to this request to the extent that it purports to
5 require the production of documents protected by the attorney-client privilege, the work
6 product doctrine, and/or any other privileges or immunities. Subject to and without waiving
7 the foregoing objections Google responds that it will produce documents as stated in its
8 response to Request for production No. 107.

9 **WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:**

10 Documents relating to licenses or agreements between Google and Terra Lycos
11 regarding sponsored links, including regarding the accused system, are relevant to the
12 damages to which Overture is entitled by this lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The
13 discovery requested is proportional to the importance of the damages issue to the case and
14 Overture’s need for the information to prepare its damages case and analysis, is not
15 unreasonably cumulative or duplicative, and cannot be found from a source other than
16 Google without substantial difficulty, if at all. *See* Fed. R. Civ. P. 26(b)(2).

17 Overture hereby incorporates by reference its discussion of the lack of justification
18 for further delay regarding Request No. 26.

19 **REQUEST FOR PRODUCTION NO. 110:**

20 All documents relating to any licenses, agreements, partner agreements, or letters of
21 intent entered into by Google and Terra Lycos relating to paid links, including, but not
22 limited to, any licenses, agreements, partner agreement, or letters of intent.

23 **RESPONSE TO REQUEST FOR PRODUCTION NO. 110:**

24 Google objects to this request on the ground that the phrase “paid links” is overly
25 broad to the extent that it includes “paid links” at are beyond the scope of AWS, which is
26 the only service that Overture has asserted allegedly infringes the patent in suit, and thus
27 this request seeks in part documents that are neither relevant to the claims or defenses raised
28 in this action, nor reasonably calculated to lead to the discovery of admissible evidence.

Google objects to this request to the extent that it seeks document is concerning any Google's Sponsored Search System that ceased to be used prior to the issuance of the Patent-in-Suit, on July 31, 2001. Google's response is limited to Google's Sponsor Search Systems that have been in use since the issuance of the Patent-in-Suit. Based on discussions between counsel for Overture and Google, Google understands the term "Google's sponsored Search System" to be limited to advertising models that are priced on a "cost-per-click" pricing model. Based on that understanding and the time limitation noted above, Google and understands the term "Google's Sponsored Search System" to be limited to AWS. Google further o objects to this request to the extent that it purports to require the production of documents protected by the attorney-client privilege, the work product doctrine, and/or any other privileges or immunities. Subject to and without waiving the foregoing objections, Google responds that it will produce documents as stated in its response to Request for Production No. 107.

WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

Documents relating to licenses or agreements between Google and Terra Lycos regarding paid links, including regarding the accused system, are relevant to the damages to which Overture is entitled by this lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The discovery requested is proportional to the importance of the damages issue to the case and Overture's need for the information to prepare its damages case and analysis, is not unreasonably cumulative or duplicative, and cannot be found from a source other than Google without substantial difficulty, if at all. *See* Fed. R. Civ. P. 26(b)(2).

Overture hereby incorporates by reference its discussion of the lack of justification for further delay regarding Request No. 26.

REQUEST FOR PRODUCTION NO. 112:

All documents relating to any indemnification, promise of indemnification, or hold harmless agreement given by Google to Terra Lycos with respect to the '361 patent or any of the claimed subject matter thereof.

RESPONSE TO REQUEST FOR PRODUCTION NO. 112:

1 Google objects to this request to the extent that it calls for documents protected by
2 the attorney-client privilege, the work product ‘doctrine, and/or any other privileges or
3 immunities. Google further objects to this request to the extent that the phrase “with respect
4 to the ‘361 patent” calls for a legal conclusion. Subject to and without waiving the
5 foregoing objections, Google responds that it will produce non-privileged documents
6 responsive to this request to the extent that they exist and have not already been produced.
7 To the extent that any such documents relate only to damages issues, pursuant to the parties’
8 agreement to phase damages discovery, such documents will be produced in the damages
9 phase of discovery.

10 WHY OVERTURE IS ENTITLED TO THE REQUESTED DISCOVERY:

11 Documents relating to indemnification agreements given by Google to Terra Lycos
12 with respect to the ‘361 patent at issue in this lawsuit are relevant to the damages to which
13 Overture is entitled by this lawsuit. *See* Fed. R. Civ. P. 26(b)(1). The discovery requested
14 is proportional to the importance of the damages issue to the case and Overture’s need for
15 the information to prepare its damages case and analysis, is not unreasonably cumulative or
16 duplicative, and cannot be found from a source other than Google without substantial
17 difficulty, if at all. *See* Fed. R. Civ. P. 26(b)(2).

18 Overture hereby incorporates by reference its discussion of the lack of justification
19 for further delay regarding Request No. 26.
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